

REMARKS

Applicants submit that the amendments herein are fully supported in the present specification as filed and add no new matter. It is respectfully requested that the present Reply be entered into the Official File in view of the fact that the Reply automatically places the application in condition for allowance. Thus, the present Reply is believed to be in proper form for placing the application in condition for allowance.

In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Reply be entered for purposes of an Appeal. The Reply reduces the issues on appeal by overcoming the rejection under 35 U.S.C. § 112, first paragraph or the rejection under § 103(a). Thus, the issues on appeal would be reduced.

Status of the Claims

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

In the present Reply, claims 2 and 3 have been amended. Also, claims 1, 4-7 and 9-21 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 2, 3, 8 and 22-28 are pending in the present application.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. Specifically, the amendments to claims 2 and 3 have support in the present specification at page 26, lines 15-17.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, First Paragraph

Claims 2, 8 and 22-25 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted failure to comply with the written description requirement (see paragraph 4 of the Office Action). Applicants respectfully traverse in that no new matter is present in the disputed claims, and reconsideration and withdrawal of this rejection are respectfully requested.

Applicants herein attach a Declaration pursuant to 37 C.F.R. § 1.132 signed by one of the co-inventors for this application (the Examiner requests express or inherent support for the disputed claim language at page 3, lines 11-12 of the Office Action). The Rule 132 Declaration specifically discusses how the adhesive layer is formed on the adhesive sheet, wherein the adhesive layer becomes solid during the manufacturing process. Further, the attached Declaration states (how one of skill in the art would understand) that the solid adhesive layer is explicitly or inherently supported in the present specification, wherein the solid characteristic is a result of the manufacturing process. Applicants further note that an application need not describe its invention *in haec verba* in order to comply with the description requirement of section 112. *Standard Oil*, 664 F.2d at 364, 212 USPQ at 334; 494 F.Supp. at 383-84, 206 USPQ at 693. See also *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984); *In re Kaslow*, 707

F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *Flynn v. Eardley*, 479 F.2d 1393, 1935, 178 USPQ 288, 290 (C.C.P.A. 1973); *Application of Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796-97 (C.C.P.A. 1971). Instead, the relevant inquiry is “whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d at 1375, 217 USPQ at 1096). See also *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985); *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (C.C.P.A. 1976). The attached Declaration shows such conveyance to the skilled artisan.

Thus, based on the specification as well as the Rule 132 Declaration, Applicants respectfully submit that the skilled artisan would understand that pending claims fully comply with the requirements of 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of this rejection is respectfully.

Issues Under 35 U.S.C. § 103(a)

Claims 3 and 24-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11-254656 (computer translation; hereinafter referred to as “JP ‘656”) as set forth in section 6 of the Office Action of July 28, 2004, with the additional reasoning set forth in paragraph 5 of the

JP '656 "is pasted to the screen printing plate to adhere and absorb the ink, so as to remove the ink from the printing plate." However, JP '656 describes adsorbing the ink, not absorbing as stated in the Office Action. One of ordinary skill in the art would understand that the JP '656 sheet acts by the different adsorption means.

(ii) The adhesive sheet of the present invention

In contrast to the JP '656 sheet, it is essential for present invention that the sheet for the removal of a solvent-containing substance that the layer exhibit the ability or function of removing a solvent-containing substance as an "adhesive layer". Such a feature leads to a different means of removing the solvent-containing substance.

In this regard, Applicants herein submit a second Rule 132 Declaration showing the unexpected advantages of the present invention. As recited in claim 3, the present invention achieves no staining as observed on a stainless steel plate (a SUS 430BA plate) by visual inspection when the pressure-sensitive adhesive sheet after absorbing 5 g/m² of the solvent is stuck to the stainless steel plate by a reciprocating motion of a 2-kg rubber roller and is peeled off from the stainless steel plate. Such an unexpected result can be seen from the attached Declaration (see Example A). Also, the removal of a solvent-containing substance is not only efficient, but there is no contamination or staining of a surface of an article that is treated with the claimed adhesive layer (after absorbing the solvent). Further, such lack of contamination is done in a relatively short time. Such properties do not exist in the JP '656 embodiment (see Example 3 in the Declaration) as explained below.

(iii) Distinctions over JP ‘656

As stated above, the present invention is clearly and patentably differ in terms of composition and mechanism (function of removing an ink and a solvent-containing substance) versus the cited JP ‘656 embodiment. Instead, JP ‘656 completely fails to disclose, recognize or consider that an adhesive can absorb an ink (JP ‘656 discloses adsorption) in a short time, or that an article to be treated is not stained by the adhesive, as instantly claimed and achieved. Also with regard to page 4, line 4 of the Office Action, one of ordinary skill in the art would understand that the JP ‘656 sheet adsorbs and not absorbs as discussed above. Thus, Applicants submit that this rejection has been overcome since U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). In this regard, JP ‘656 fails to disclose at least the feature of no staining as instantly claimed. Thus, this rejection has been overcome.

Furthermore, comparative examples 1 and 2 of JP ‘656 show that “removal of ink” is marked as “X” (adhesiveness on rough surface of screen mesh is low, and removal of the ink is wrong). According to these disclosed results, it is clear that a general adhesive sheet having rubber or acrylic adhesive layer in JP ‘656 does not exhibit adhesiveness, and does not achieve the removal property without staining as achieved by the present invention. These are additional reasons as to why the instant rejection should be withdrawn.

Applicants note that the Examiner states that the foam layer in JP ‘656 is not relevant: “JP ‘656 teaches additional structural element (i.e., foamed structure) not claimed is irrelevant” (see the Office Action at page 4, last three lines). Applicants respectfully disagree since an analysis under 35 U.S.C. § 103(a) requires a determination of the scope and content of the prior art, *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and any cited reference used for a rejection under 35 U.S.C. § 103(a) must be considered in its entirety, i.e., as a whole, including those portions that would lead away from a claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). One of skill in the art would consider the foam layer in JP ‘656, as further evidenced by the Rule 132 Declaration.

Also, in consideration of the JP ‘656 embodiment having the foam layer, JP ‘656 shows a sheet for cleaning having a foam layer composed by rubber latex of example 1 and a sheet for cleaning having a foam layer formed by an acrylic pressure-sensitive adhesive and heat-expansion microcapsule. Both of these components do not match what is instantly claimed (see pending claim 3). Thus, under *Vaeck*, JP ‘656 does not disclose all instantly claimed features

and this rejection has been overcome. Additionally, the efficiency for removing a solvent-containing substance of the cited reference sheet is less than the sheet as achieved by the present invention as explained above. Applicants' position regarding the unexpectedly better removal property is also supported by the enclosed Rule 132 Declaration and the experimental results shown in Applicants' specification. Thus, the present invention is patentably distinguishable from the disclosure in JP '656.

Overall, Applicants respectfully submit that the present invention is patentably distinguishable in terms of composition and properties over the cited JP '656 reference. More specifically, the present invention is completely different in the components used or composition, removal properties, and mode of action. Further, JP '656 fails to suggest that the unexpectedly better properties of adhesive as well as the little or no staining involved after removal of the solvent-containing substance. Thus, Applicants submit this rejection has been overcome, and reconsideration and withdrawal of this rejection are respectfully requested.

Unexpected results rebut the instant rejection

Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on JP '656 or any other reference or combinations thereof). *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); *see also In re Papesch*, 315 F.2d 381, 137 USP 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967). As mentioned, Applicants have shown

unexpectedly better adhesive, removal and non-staining properties over the cited JP '656 embodiment.

In the present invention, the present inventors found that a solvent-containing substance attached to an article to be treated can be efficiently removed and a surface of the article to be treated does not contaminate or stain by the component of the adhesive layer when removing the solvent-containing substance by using the claimed adhesive. The instantly claimed adhesive has the property removing the solvent-containing substance after a specific (or more) amount of the solvent absorption in a relatively short time. Further in the present invention, there is no transfer of the component of the adhesive layer in case of the peeling test after absorbing a certain amount of solvent. Such properties are also evident upon review of the attached Declaration.

The enclosed Rule 132 Declaration is evidence of the unexpected results for the present invention. As further recited in claim 3, the Declaration shows how the present invention (Example A in the Declaration) achieves no staining as observed on a stainless steel plate (a SUS 430BA plate) by visual inspection when the pressure-sensitive adhesive sheet after absorbing 5 g/m² of the solvent is stuck to the stainless steel plate by a reciprocating motion of a 2-kg rubber roller and is peeled off from the stainless steel plate. However, the JP '656 embodiment (Example B) has staining and achieves inferior results.

Accordingly, consideration of the unexpected results as rebutting the rejection under § 103(a) and withdrawal of this rejection are respectfully requested.

Information Disclosure Statement

Applicants have not yet received a returned copy of the PTO-1449 form having the Examiner's initial next to each considered reference for the Information Disclosure Statement ("IDS") filed on September 26, 2003. Thus, Applicants respectfully request a copy from the Examiner.

Applicants further note that another IDS was filed on June 2, 2005 (after issuance of the outstanding Office Action). Thus, Applicants also request an initialed copy of the reference form for the June 2 IDS.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

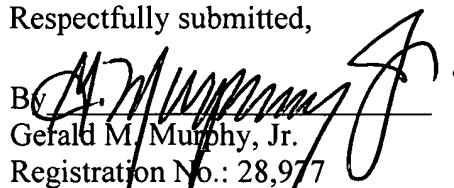
*Application No. 09/936,930
Art Unit 1771
After Final Office Action of March 18, 2005*

Docket No.: 3273-0146P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 18, 2005

Respectfully submitted,

By 
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachments:

First Declaration Pursuant to 37 C.F.R. § 1.132
Second Declaration Pursuant to 37 C.F.R. § 1.132